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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/844,322 | 04/26/2001 | Casey William Norman | 1391-CON-00 | 1969 |

7590 04/10/2002

Schnader Harrison Segal & Lewis LLP
1600 Market Street, Suite 3600
Philadelphia, PA 19103-7286

EXAMINER

FRANCIS, FAYE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3712

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 25-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 47-51 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 is indefinite since the claims appear to recite further limitations on the doll when no doll appear to have been positively recited in these claims or in the claims from which they depend. Additionally, it is not clear how the functional limitations recited in lines 1-3, are intended to further limit the garment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20-23, 25-32 and 47-51 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda.

Yasuda discloses a seamless [Fig 1] doll's garment [col 19, 2nd line from the bottom] formed from an injection molded [col 5 line 42] thermoplastic [claim 8] elastomer as recited in claims 21, 22 and 47, wherein the thermoplastic elastomer is containing styrene [col 3 lines 18-54] as recited in claims 20 and 47 and the garment includes a

Art Unit: 3712

detail/ribbon [col 19 last line] as recited in claims 23, 29, 48 and 49, the colorless injected molded thermoplastic elastomer transparent, col 4 line 6] as recited in claim 27, but does not disclose the garment has a wall thickness from 1 to 3 mm as recited in claims 20-21 and 47, the thermoplastic elastomer has an average modulus of elasticity of less than 1 MN/m² as recited in claims 22 and 30-32, 47 and 50-51, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26 and the garment is less than 8 cm in height as recited in claim 28.

Moreover the limitations in claims 25 and 49 are presumed to be inherent in the device of Yasuda [col 19 last paragraph and col 20 first paragraph].

With respect to claims 20-21 and 47, it would have been obvious to provide the garment of Yasuda in the claimed thickness for the purpose of making the devices easier to play with.

With respect to claims 22 and 30-32, 47 and 50-51, it would have been obvious to construct the device of Yasuda to have the claimed average modulus of elasticity for the purpose of having good elasticity and deformability.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to modify the Yasuda's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to provide the garment of Yasuda in the claimed height for the purpose of making the devices easier to play with.

Art Unit: 3712

5. Claims 33-46 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of Gross.

Yasuda discloses most of the features of these claims as disclosed above in paragraph 4, but does not disclose a play set comprising a doll as recited in claims 33 and 38 wherein doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips as recited in claims 34 and 38, the garment has a wall thickness from 1 to 3 mm as recited in claims 33 and 38, the thermoplastic elastomer has an average modulus of elasticity of less than 1 MN/m² as recited in claims 38 and 41-43, a plurality of seamless garments as recited in claim 44 and a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to provide the device of Yasuda with the doll disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with by having a complete set [doll and the doll's garment].

With respect to claims 33 and 38, it would have been obvious to provide the garment of Yasuda in the claimed thickness for the purpose of making the devices easier to play with.

With respect to claims 38 and 41-43, it would have been obvious to construct the device of Yasuda to have the claimed average modulus of elasticity for the purpose of having good elasticity and deformability.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to modify the Yasuda's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

Response to Arguments

6. Applicant's arguments filed 1/17/02 have been fully considered but they are not persuasive.

In response to the argument that Yasuda does not show the seamless clothing, the examiner would like to point out that the material/fabric/clothing disclosed in Figs 1 of Yasuda is clearly considered to be seamless. Additionally, the "garment" as broadly as claimed, the material can be considered as the "garment".

In response to the argument that Yasuda shows a laminate which has a thickness and modulus of elasticity vastly different from that of the present invention, the examiner would like to point out that the question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385,

Art Unit: 3712

163 USPQ 545 (CCPA 1969). In this case, the artisan would have been motivated to modify Yasuda's garment to have claimed thickness and claimed modulus of elasticity for the purpose of making the devices easier to play with and for the purpose of having good elasticity and deformability respectively. Furthermore, there is no indication that Yasuda's material cannot change shape with thicker material.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers

Application/Control Number: 09/844,322

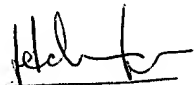
Page 7

Art Unit: 3712

for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF
March 29, 2002


Jacob K. Ackun
Primary Examiner